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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,356	04/15/2004	Toshiyuki Suzuki	4826-0104PUS1	6311
2292	7590	09/25/2006	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			GEISEL, KARA E	
			ART UNIT	PAPER NUMBER
			2877	
DATE MAILED: 09/25/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/824,356

Applicant(s)

SUZUKI, TOSHIYUKI

Examiner

Kara E. Geisel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 12 and 13 is/are rejected.
- 7) ☒ Claim(s) 8-11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 0704, 1105.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

The certified copy has been filed in this application on April 15th, 2004.

Information Disclosure Statement

The information disclosure statements filed July 15th, 2004 and November 21st, 2005 have been considered by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regards to claim 4, line 3 it is not clear whether the fundamental data or the refractive index is based upon "angle of incidence-degree of refraction" relationships relating to at least three different angles of incidence obtained for one surface of the lens. Clarification is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-4 are rejected under 35 U.S.C. 101 because merely calculating (claim 1, line 5) would not appear to be sufficient to constitute a tangible result, since the outcome of the calculating step has not been used in a disclosed practical application nor made available in such a manner that its usefulness in a

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disclosed practical application can be realized. See OG Notices: 22 November 2005, "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility".

Part b. *Practical Application the Produces a Useful, Concrete, and Tangible Result* under Section IV *Determine Whether the Claimed Invention Complies with the Subject Matter Eligibility Requirement of 35 U.S.C. Sec. 101*, sentence 3, in the OG Notice from 22 November 2005 states 'In determining whether the claim is for a "practical application," the focus is not on whether the steps taken to achieve a particular result are useful, tangible, and concrete, but rather that the final result achieved by the claimed invention is "useful, tangible, and concrete."' Since the last step in claims 1-4 are not tangible, the entire claims are deemed to not comply with subject matter eligibility requirements.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Manning (USPN 5,760,889).

In regards to claim 1, Manning discloses a method for measuring fundamental data of a lens, comprising illuminating the lens (fig. 7, 31) with a light (32) at a predetermined angle of incidence (36, which is identical to fig. 4, 7, which converts the light from the light source 1 to a predetermined angle of incidence), measuring degree of refraction of the transmitted light that passes through the lens (via 35), and calculating the fundamental data of the lens based upon a plurality of "angle of incidence - degree of refraction" relationships obtained by measuring the degree of refraction with respect to a plurality of different angles of incidence (column 2, lines 49-67 and column 5, lines 29-56).

In regards to claim 2, the calculating step comprises the step of calculating the fundamental data of the lens based upon the “angle of incidence-degree of refraction” relationships relating to at least three different angles of incidence obtained for each of the two surfaces of the lens (as can be seen by fig. 4, the scanner 26 directs the light in three distinct angles towards the lens 4. Furthermore it is disclosed that the scanner can be used in fig. 7 to scan across many angles (column 5, lines 33-37)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-7, and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manning (USPN 5,760,889).

In regards to claim 5, Manning discloses a device for measuring the fundamental data of a lens (figs. 4 and 7) comprising means (1, 32) for illuminating the lens (4, 31) at a plurality of different angles of incidence (26 scans the light across the lens at different angles), means for detecting transmitted light that passes through the lens (35), a processor (11) in communication with the illuminating means and the detecting means, the detecting means communicating signals corresponding to the transmitted light to the processor (column 2, lines 55-67; generally discloses the communication of the detectors to the processor; detector 35 would have the same process), wherein the processor calculates the degree of refraction of the transmitted light that passes through the lens based upon the output signal of the detection means, and calculates the fundamental data of the lens based upon a plurality of “angle of incidence-degree of refraction” relationships obtained for a plurality of different angles of incidence (column 5, lines 29-56). It is not disclosed that the processor causes illumination of the lens with the light from the illuminating

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means at the predetermined angles of incidence. However, the Examiner takes Official Notice, that it is well known in the art to have the processor control the light source of a measurement system, as well as the scanning means which controls the angles of incidence, in order to automate the measurement system, making the device run much more efficiently. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the processor of Manning's device cause illumination of the lens with the light from the illuminating means at the predetermined angles of incidence in order to automate Manning's system, therefore making it more efficient.

In regards to claim 6, the device further comprises means for displaying the fundamental data calculated by the processor (fig. 4, 15).

In regards to claim 7, the display and processor can show any type of graphical representation of the measured data that the user desires.

In regards to claim 12, the illuminating means comprises a plurality of light sources (column 3, lines 37-39 and 46-50) with different distances from the lens (fig. 7, has the beams of the light sources starting perpendicular to the lens 31. Therefore each light source representing a specific beam angle would be at a different distance from the lens), and a reflective mirror for illuminating the lens with light from any of those light sources (33).

In regards to claim 13, the illuminating means illuminates the lens at no less than two of the three different types of illumination angles: divergent, parallel, and condensing (fig. 4).

Allowable Subject Matter

Claim 3 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101, set forth in this Office action.

Claims 8-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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The following is a statement of reasons for the indication of allowable subject matter:

As to claim 3, the prior art of record, taken alone or in combination, fails to disclose or render obvious a method for measuring fundamental data of a lens comprising measuring a thickness of the lens, where the calculating step comprises a step of calculating fundamental data of the lens based upon an “angle of incidence-degree of refraction” relationships relating to at least two different angles of incidence obtained for each of the two surfaces of the lens **and** the thickness of the lens, in combination with the rest of the limitations of claim 3.

As to claim 8, the prior art of record, taken alone or in combination, fails to disclose or render obvious a device for measuring the fundamental data of a lens wherein an illuminating means comprises a means for changing the optical distance between a light source and the lens, in combination with the rest of the limitations of claim 8.

Conclusion

Several facts have been relied upon from the personal knowledge of the examiner about which the examiner took Official Notice in this Office Action mailed. Applicant must seasonably challenge well known statements and statements based on personal knowledge when they are made by the Board of Patent Appeals and Interferences. In re Selmi, 156 F.2d 96, 70 USPQ 197 (CCPA 1946); In re Fischer, 125 F.2d 725, 52 USPQ 473 (CCPA 1942). See also In re Boon, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice). If applicant does not seasonably traverse the well-known statement during examination, then the object of the well-known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). A seasonable challenge constitutes a demand for evidence made as soon as practicable during prosecution. Thus, applicant is charged with rebutting the well-known statement in the next reply after the Office action in which the well-known statement was made.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kara E Geisel whose telephone number is **571 272 2416**. The examiner can normally be reached on Monday through Friday, 8am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory J. Toatley, Jr. can be reached on **571 272 2800 ext. 77**. The fax phone number for the organization where this application or proceeding is assigned is **571 273 8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



F.L. Evans
Primary Examiner
Art Unit 2877

K.G.,
KEG
September 15, 2006